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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) KOLS.047PA | | | | | | | | | |
| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>April 27, 2009</u> Signature <u>/Rennae Johnson/</u> Typed or printed name <u>Rennae Johnson</u> | Application Number 10/659,777 | Filed September 10, 2003 | | | | | | | | | |
| | First Named Inventor HAVERINEN | | | | | | | | | | |
| | Art Unit 2617 | Examiner Ajayi, J. | | | | | | | | | |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%; border: none;"><tr><td style="width: 50%; vertical-align: top;"><input type="checkbox"/> applicant/inventor.</td><td style="width: 50%; vertical-align: top;"><u>/Erin M. Nichols/</u> _____ Signature</td></tr><tr><td style="vertical-align: top;"><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td style="vertical-align: top;"><u>Erin M. Nichols</u> _____ Typed or printed name</td></tr><tr><td style="vertical-align: top;"><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>57,125</u></td><td style="vertical-align: top;"><u>952-854-2700</u> _____ Telephone number</td></tr><tr><td style="vertical-align: top;"><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td><td style="vertical-align: top;"><u>April 27, 2009</u> _____ Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> | | | | <input type="checkbox"/> applicant/inventor. | <u>/Erin M. Nichols/</u> _____ Signature | <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) | <u>Erin M. Nichols</u> _____ Typed or printed name | <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>57,125</u> | <u>952-854-2700</u> _____ Telephone number | <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____ | <u>April 27, 2009</u> _____ Date |
| <input type="checkbox"/> applicant/inventor. | <u>/Erin M. Nichols/</u> _____ Signature | | | | | | | | | | |
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| <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>57,125</u> | <u>952-854-2700</u> _____ Telephone number | | | | | | | | | | |
| <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____ | <u>April 27, 2009</u> _____ Date | | | | | | | | | | |
| <input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted. | | | | | | | | | | | |

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9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

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|-------------------|--------------------|-----------------|------------|
| Applicant: | HAVERINEN | Examiner: | Ajayi, J. |
| Serial No.: | 10/659,777 | Group Art Unit: | 2617 |
| Filed: | September 10, 2003 | Docket No.: | KOLS.047PA |
| Confirmation No.: | 4888 | Customer No.: | 76385 |
| Title: | HANDOVER | | |

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being transmitted to the U.S. Patent and Trademark Office via the Office electronic filing system in accordance with 37 CFR 1.6(a)(4) on April 27, 2009.

By: /Rennae Johnson/
Rennae Johnson

**APPELLANT'S STATEMENT IN SUPPORT OF PRE-APPEAL BRIEF
REQUEST FOR REVIEW**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This statement is presented by Appellant in compliance with the USPTO OG Notice of 12 July 2005, regarding the New Pre-Appeal Brief Conference Pilot Program. Appellant is requesting a pre-appeal conference on the belief that the rejection of record is clearly not proper and is without basis. Appellant's request is based upon a clear legal or factual deficiency in the rejection, rather than an interpretation of the claims or the prior art teachings. As such, Appellant believes this request for pre-appeal review is appropriate.

Each of the rejections (§§ 102(e) and 103(a)) of the pending claims is based primarily on the teachings of U.S. Patent No. 6,654,359 to La Porta (hereinafter "La Porta"); for example, each of the independent claims (Claims 1, 13, 16, 19, and 26) is rejected under § 102(e) in view of La Porta.

While Appellant has multiple issues for appeal, the primary purpose for submitting this particular request for review concerns omissions of essential elements required for a *prima facie* anticipation rejection. Although each of the independent claims is rejected in the final Office Action (dated December 30, 2008) in view of La Porta, La Porta does not teach the claimed limitations as asserted in the final Office Action or in the Advisory Action dated April 9, 2009.

The example limitations at issue for purposes of this request for review relate to transferring a tunneling IP address from a first access device (from which a terminal is being handed over) to a second access device. To establish a *prima facie* § 103(a) rejection of at least the independent claims, these limitations must be present in La Porta, as the Examiner alleges.

In the Advisory Action the Examiner relies upon newly-cited portions of La Porta at column seven that have not previously been identified. With these citations, the Examiner appears to assert that La Porta's home agent and care-of address are access devices. However, the home agent or the care-of address is not an access device connected to a terminal, as claimed. In contrast, the cited portion is directed to updating a routing table to take into account the transit of a mobile station from an old base station to a new base station within a foreign domain. Notably, Col. 7, lines 32-34, teaches that the routing table is updated to direct a packet to the new base station; therefore, the same care-of address can be maintained when the mobile station moves between base stations of the same domain. Thus, the newly-cited portions of La Porta are not applicable to the claim limitations directed to transferring a tunneling IP address between access devices.

In the final Office Action the Examiner contends that the handoff path setup message transmitted in case of handoff between base stations in a current domain (Col. 10, lines 46-63) corresponds to the claimed transfer of a tunneling IP address from a first access device (from which a terminal is being handed over) to a second access device. However, La Porta explicitly describes at Col. 21, lines 45-47 (emphasis added), "The mobile device 114 then transmits the handoff path setup message over a first hop 450 to base station BS10 IntfB." It is further explained that IP packet routing information is updated on the basis of this message, and then the 'new base station' BS10 forwards the handoff path setup message to the 'old base station' BS9 (Fig. 15) or the handoff path setup message is transferred to the old base station BS9 via a router (Fig. 14). The old base station (from which the mobile device is being handed over) merely transmits an acknowledgement. Thus, La Porta does not teach that a tunneling address is transferred from an 'old/first access device' to a 'new/second access device', as claimed. Rather, in La Porta the asserted base station merely acts as a router, *see, e.g.*, Col. 21, lines 50-54 and Col. 22, lines 35-36. Since La Porta fails to teach transferring the tunneling IP address as claimed, La Porta also fails to correspond to the limitations directed to a second access device

based on the tunneling IP address received from the first access device. Without correspondence to each of the claimed limitations, the rejections are improper, and the rejections should be reversed.

In addition, Appellant maintains that the base stations of La Porta are not disclosed as having any tunneling related functionality, as claimed. The references to tunneling at columns seven and ten refer to a home agent HA that tunnels packets between a home domain and a foreign domain on the basis of mapping between a local address (care-of address in the foreign domain) and home address in the home domain. *See, also*, Col. 5, lines 18-21. While the local IP address is used in the foreign domain to identify a mobile device and to route packets from the HA to the device, this is performed via normal IP routing. As a skilled artisan would recognize, in Mobile IP the mere transmission of tunneled IP packets via a base station does not mean that the base station has some (IP protocol layer) tunneling capability, and La Porta's base stations do not have any tunneling functionality related thereto. Thus, the asserted access devices of La Porta do not correspond to the claimed first and second access devices.

In order to maintain at least the § 102(e) rejection of the independent claims, the Examiner must present correspondence to every element of the claims. The Federal Circuit recently held that "Because the hallmark of anticipation is prior invention, the prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements 'arranged as in the claim.'" (Net Moneyin, Inc. v. Verisign, Inc., 545 F.3d 1359, 2008 (Fed. Cir. 2008) quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983)). Therefore, all claim elements, and their limitations, must be found in the prior art reference to maintain the rejection based on 35 U.S.C. § 102. Appellant respectfully maintains that La Porta does not teach every element of independent Claims 1, 13, 16, 19, and 26 in the requisite detail, and therefore fails to anticipate Claims 1, 2, 8, 13, 15-17, 19, 20, 24-28, and 32. Accordingly, Appellant requests that the rejection be reversed.

Although La Porta is solely relied upon as teaching these limitations, the additional reliance on the teachings of Johansson does not overcome the above-discussed deficiencies in the teachings of La Porta.

With respect to the § 103(a) rejection of dependent Claims 6, 7, 14, 18, 21-23, and 29-31, Appellant respectfully maintains the traversal because the further relied-upon teachings of Johansson have not been shown to teach or suggest transferring a tunneling IP address from a first access device (from which the terminal is being handed over) to a second access device. Moreover, with respect to the rejection of Claims 7, 14, 18, 21, 23, 29, and 31, the Examiner fails to assert any rationale for combining the alleged teachings of Johansson with those of La Porta. The mere assertion that Johansson may teach the claimed limitations fails to provide the requisite support for a § 103(a) rejection. Since the asserted teachings have not been shown to correspond to each of the claimed limitations, and no rationale for combining certain of the teachings has been presented, the § 103(a) rejection is improper. Appellant accordingly requests that the § 103(a) rejection be reversed.

It is respectfully submitted that there is an omission of at least one essential element needed for a *prima facie* anticipation rejection. La Porta does not teach or suggest at least transferring a tunneling IP address from a first access device (from which a terminal is being handed over) to a second access device. In the Office Action, La Porta is solely relied upon in each of the prior art rejections as teaching these claimed features. Because La Porta does not involve or otherwise address transferring a tunneling IP address from a first access device (from which a terminal is being handed over) to a second access device, Appellant believes these claim limitations are improperly being overlooked, and consequently there is an omission of an essential element(s) required for a *prima facie* rejection.

It is Appellant's position that the Examiner's reliance on La Porta in each of the rejections as teaching transferring a tunneling IP address from a first access device (from which a terminal is being handed over) to a second access device is inappropriate, as La Porta does not address this.

Appellant believes that this statement, when viewed together with the prosecution history, sets forth clear grounds for a finding that the rejections based upon La Porta are improper and without basis.

The undersigned is of record and with authority to prosecute the appeal on behalf of the Assignee.

Respectfully submitted,

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